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09/580,412

05/30/2000

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EXAMINER

FLORES SANCHEZ, OMAR

ART UNIT

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3724

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/580,412
Filing Date: May 30, 2000
Appellant(s): JENKINS, HENRY H.

Kenneth L. Mitchell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/26/08 appealing from the Office action mailed 03/08/07.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 19 and 25 under 35 U.S.C. 112 has been withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(7a) Evidence Appendix

None

(8) Evidence Relied Upon

| | | |
|-----------|-----------------------|---------|
| 1,635,964 | W. W. SHINNICK | 07-1927 |
| 3,464,293 | K. S. SVENDSEN ET AL. | 09-1969 |
| 6,085,625 | SANDFORD | 07-2000 |
| 3,335,628 | J. T. W. SIMMS ET EL. | 08-1967 |
| 5,943,935 | BRAYTON ET AL. | 08-1999 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 14, 15, 17, 20, 21 and 23 are rejected under 35 U.S.C 102(b) as being anticipated by Shinnick (1635964).

Shinnick discloses (Fig. I-XI) the invention including a steel rule/metal member *C* and *S*, a cutting edge is defined by a generally triangular shape configuration (see Fig. IX), a bottom portion, first and second end portions extending in a first and a second directions (see Fig. VIII), and a flat configuration (see Fig. IX).

2. Claims 20-22 and 23 are rejected under 35 U.S.C 102(b) as being anticipated by Svendsen et al. (3464293).

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Svendsen et al. discloses (Fig. 1-21) the invention including a steel rule/metal member (Fig. 20), a first end portion extending at angle 44 (see Fig. 14-17), a cutting edge is defined by a generally triangular shape configuration (see Fig. 4) and the end portion formed at approximately a 45 degree angle (the end portion having a range between 10 to 90 degrees angle, see col. 3, lines 59-67).

3. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinnick (1635964) in view of Sandford (6085625) and Svendsen et al. (3464293).

Shinnick discloses (Fig. 1-6) the invention substantially as claimed including a top board 1, 11 and *F*, a plurality of rule slots 12, a steel rule/metal member *C* and *S*, a cutting edge is defined by a generally triangular shape configuration (see Fig. IX), slots (see Fig. IV) formed from the bottom portion of the rule, and first and second end portions (see Fig. I). Shinnick does not show a metal plate. However, Sandford teaches the use of a metal plate 52 for the purpose of increasing the stability of the rule die. It would have been obvious to one of having ordinary skill in the art at the time of the invention was made to have modified Shinnick's device by providing the metal plate as taught by Sandford in order to obtain a device that improves the stability of the rule die.

Shinnick doesn't show a first portion extending at approximately a 45 degree angle, and the first end portion of the steel rule engaging the next adjacent steel rule to form 45 degree angled corner. However, Svendsen et al. teaches an end portion having a range between 10 to 90 degrees angle (see col. 3, lines 59-67) for the purpose of creating the desired shape of cut. It would have been obvious to one of having ordinary skill in the art at the time of the invention

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was made to have modified Shinnick's device by providing the approximately 45 degree angle in order to create the desired shape of cut.

4. Claims 16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinnick (1635964) in view of Svendsen et al. (3464293).

Shinnick discloses the invention substantially as claimed except for end portions formed at approximately 45 degree angle. However, Svendsen et al. teaches an end portion having a range between 10 to 90 degrees angle for the purpose of creating the desired shape of cut. It would have been obvious to one of having ordinary skill in the art at the time of the invention was made to have modified Shinnick's device by providing the approximately 45 degree angle in order to create the desired shape of cut.

5. Claims 18, 19, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinnick (1635964) in view of Simms et al. (3335628).

Shinnick discloses the invention substantially as claimed including slots (see Fig. IV). Shinnick doesn't show a terminating end of each of the first and second end portions formed on an angle to the vertical axis. However, Simms et al. teach the use of a terminating end of each of the first and second end portions (21 and 35) formed on an angle to the vertical axis for the purpose of facilitating the formation of strong and accurate joint. It would have been obvious to one of having ordinary skill in the art at the time of the invention was made to have modified Shinnick's steel rule by providing the terminating end of each of the first and second end portions formed on an angle to the vertical axis as taught by Simms et al. in order to facilitate the

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formation of strong and accurate joint and eliminate the gap between the cutting edges of the joint to avoid incomplete cut of the work piece.

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Svendsen et al. (3464293) in view of Simms et al. (3335628).

Svendsen discloses the invention substantially as claimed except for a terminating end of each of the first and second end portions formed on angle to the vertical axis. However, Simms et al. teach the use of a terminating end of each of the first and second end portions formed on angle to the vertical axis for the purpose of facilitating the formation of strong and accurate joint. It would have been obvious to one of having ordinary skill in the art at the time of the invention was made to have modified the steel rule of Svendsen et al. by providing the terminating end of each of the first and second end portions formed on angle to the vertical axis as taught by Simms et al. in order to facilitate the formation of strong and accurate joint and eliminate the gap between the cutting edges of the joint to avoid incomplete cut of the work piece.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Svendsen et al. (3464293) in view of Simms et al. (3335628) as applied to claims 20, 23 and 24 above, and further in view of Brayton et al. (5943935).

The modified device of Svendsen discloses the invention substantially as claimed except for slots formed at the bottom of the steel rule. However, Brayton et al. teaches the use of slots formed at the bottom of the steel rule 36 for the purpose of having a better support of the steel rule. It would have been obvious to one of having ordinary skill in the art at the time of the

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invention was made to have modified the steel rule of Svendsen et al. by providing the slots as taught by Brayton et al. in order to obtain a better support of the steel rule.

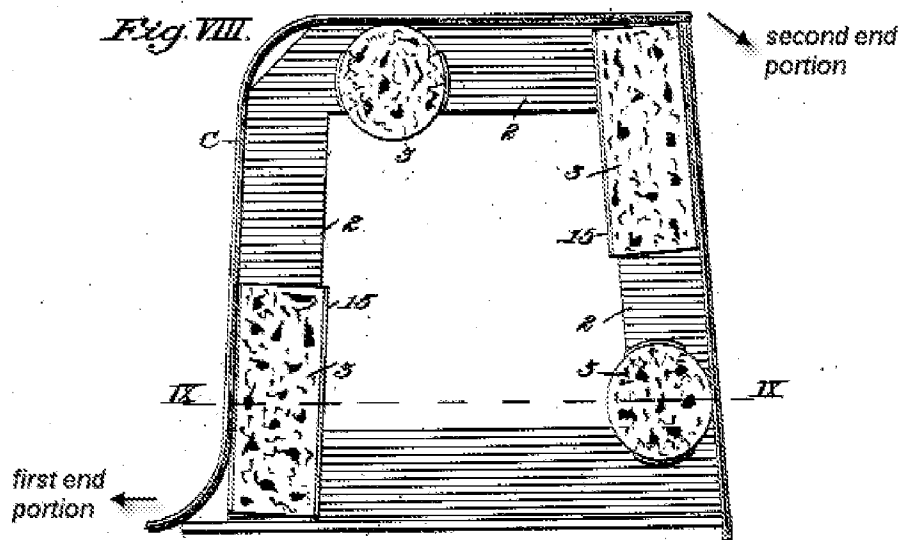
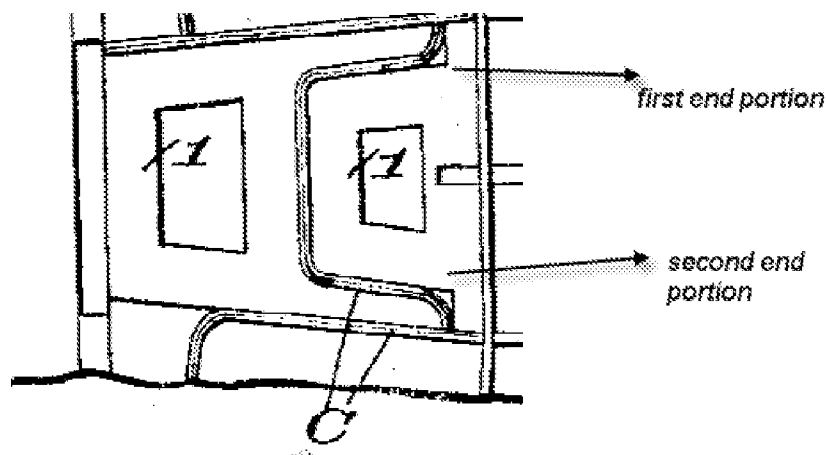
(10) Response to Argument

Issue 1

Appellant argues that, regarding claim 14, Shinnick doesn't disclose the first and second end portions which extend in opposite direction. However, Appellant admit, in page 17, lines 5-6, that any rule has first and second end portions extending in first and second directions. Appellant arguments relying only that Shinnick rules can't be arranged with each other to produce an inexpensive steel rule die. However, claim 14 cites in the preamble only a single rule for use in a steel rule die and has not positively cited any arrangement between rules to produce an inexpensive steel rule die. The office action clearly disclosed rules **C** and **S** having first and second portions extending in first and second directions as cited in claim 14, and evidence can be found in Figures **I** and **VIII**, where Fig. **I** has been partially introduced and amplified. Also, regarding the argument of claim 20, Shinnick teaches rules **C** and **S** having a first end portion extending in first direction, since the claim 14 is not a closed term any of the ends of the rules could be considered the first end portion.

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Fig. I



Issue 3

Appellant arguments are not clearly point exactly the deficiency of Svendsen et al. regarding the limitation of claim 20. Appellant again rely on the argument that “the construction

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of a rule wherein essentially identical rules may be arranged to enable an unskilled workman to make a die”. However, claim 20 cites in the preamble only a rule for use in a steel rule die and has not positively cited any arrangement between rules to enable an unskilled workman to make a die. Regarding claim 22, Appellant argues Sevenden et al. lacks the limitation of the end portion formed at 45 degree angle. However, the Office Action cited clearly that the rule can be formed to a desired angle between 10 to 90 degrees (see col. 3, lines 59-67).

Issue 4

Appellant argues in claim 11 that Sandford’s plate has slot causing lacks of support against force on the cutting edge of the rule. However, claim 11 fails to disclose the intended use recitation argue above and the claim has nothing that prohibits the use of slots. Claim 11 only cites “a metal plate” without any intended use recitation. Also, Sandford's plate is used to provide structural stability as disclosed in the specification. Appellant argues that the combination of Shinnick, Sandford and Svendsen is not constructed of identical rules with 45 degree ends which engage each other. First, claim 11 doesn't disclose any limitation of “identical rules with 45 degree ends which engage each other” only the first end portion of one rule engaging a next rule to form 45 degree angled corner. However, Svendsen teaches the end portion having an angle between 10 to 90 degrees and capable of engaging a next rule to form 45 degree angled corner to create a desired shape.

Issue 5

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Appellant argues in claim 16 that Svendsen doesn't show a 45 degree angle which enables the end to end assembly of identical rules to be used to easily construct a die. However, the above intended use recitation is not disclosed in the claim and Svendsen teaches the end portions having a 45 degree angle (see col. 3, lines 59-67, where the rule's angle lies between 10 to 90 degrees) to create a desired shape.

Issue 6

Appellant's argument of claim 18 about Simms et al. doesn't show the terminating end of each end portions formed on an angle to the vertical. The Office disagree with Appellant because Simms et al. teaches the terminating end (i.e., see Fig. 2 and 6) of each end portions formed on an angle to the vertical axis.

Appellant disagrees in claim 24 that the neither Shinnick or Simms et al. doesn't show two claimed rules can be combined to produce a corner. However, Appellant's argument is irrelevant because the limitations are not cited in the claim.

Issue 7

Appellant disagrees in claim 24 that the neither Svendsen or Simms et al. doesn't show two claimed rules can be combined to produce a corner. However, Appellant's argument is irrelevant because the limitations are not cited in the claim.

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Issue 8

Appellant argues that the slots in the bottom of the rule are patentable as a combination. However, the combination is clearly anticipated by Svendsen, Simms et al. and Brayton et al. Also, the slots in the bottom of the rule are old and well known in the art and can be applied to any rule without affecting the operation or utility of the rule.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Omar Flores-Sánchez/

Examiner, Art Unit 3724

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Boyer Ashley

/Boyer D. Ashley/

Supervisory Patent Examiner, Art Unit 3724

Joseph Hail

/Joseph Hail/

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